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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: Robert G. Everts et al.

Appln. No.: 10/666,924

Filed: September 19, 2003

For: Operator Carried Power Tool Having a  
Four-Cycle Engine and an Engine  
Lubrication Method

Examiner: Noah P. Kamen

Art Unit: 3747

Attorney Docket No: 10512/41

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL

Sir:

Attached is/are:

- ☒ Appellant's Reply to Examiner's Answer.  
☒ Return Receipt Postcard

Fee calculation:

- ☒ No additional fee is required.  
☐ Small Entity.  
☐ An extension fee in an amount of \$\_\_\_\_\_ for a \_\_\_\_\_-month extension of time under 37 C.F.R. § 1.136(a).  
☐ A petition or processing fee in an amount of \$\_\_\_\_\_ under 37 C.F.R. § 1.17(\_\_\_\_).  
☐ An additional filing fee has been calculated as shown below:

					Small Entity			Not a Small Entity	
	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	or	Rate	Add'l Fee
Total		Minus			x \$25=			x \$50=	
Indep.		Minus			X100=			x \$200=	
First Presentation of Multiple Dep. Claim					+\$180=			+\$360=	
					Total	\$		Total	\$

Fee payment:

- ☐ A check in the amount of \$\_\_\_\_\_ is enclosed.  
☐ Please charge Deposit Account No. 23-1925 in the amount of \$\_\_\_\_\_. A copy of this Transmittal is enclosed for this purpose.  
☐ Payment by credit card in the amount of \$\_\_\_\_\_ (Form PTO-2038 is attached).  
☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

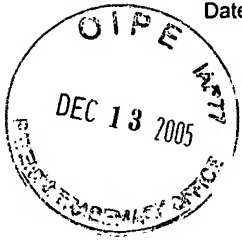
Respectfully submitted,

Robert S. Mallin (Reg. No. 35,596)

12/13/05  
Date

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Atty. Ref. No.: 10512/41

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	
	)	
ROBERT G. EVERTS, et al.	)	
	)	Examiner: Noah P. Kamen
Serial No.: 10/666,924	)	
	)	Group Art Unit No.: 3747
Filing Date: September 19, 2003	)	
	)	
For OPERATOR CARRIED POWER	)	
TOOL HAVING A FOUR-CYCLE	)	
ENGINE AND AN ENGINE	)	
LUBRICATION METHOD	)	

**APPELLANTS' REPLY TO EXAMINER'S ANSWER**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is a reply to the Examiner's Answer dated October 13, 2005. The Appellants will address the answers provided by the Examiner separately.

**I. REPLY TO EXAMINER'S ANSWER**

**A. The Examiner Provides no Motivation to Combine References**

In the Examiner's Answer at p. 4, the Examiner stated:

The examiner contends that the teaching for making the combination is to use the lubrication system of Takada et al in Kovacs because of the advantages disclosed by Takada et al and that Kovacs is silent as to the construction of any lubrication system.

The Examiner also stated (emphasis added):

The examiner contends that the motivation to combine need only come from the secondary reference regardless whether that feature is found in the pending claims.

Without specifically identifying it, the Examiner insists that the Takada et al reference includes a motivation to combine the lubrication system taught in Takada et al with the engine of Kovacs. The Appellants have continuously asserted that there is no motivation to combine Kovacs and Takada et al because the lubrication system of Takada et al would not work in the engine taught in Kovacs.

The Examiner has not explained the motivation to combine the references other than simply asserting that it exists, as was done again in the Examiner's Answer. Instead of identifying the motivation, the Examiner alleges that one skilled in the art would know how to combine the teachings of Kovacs and Takada et al. However, understanding how to combine teachings of two patents is not the same as being motivated to combine the teachings. Simply because one skilled in the art may eventually know how to combine the teachings of two different patent disclosures does not provide the motivation to combine the references. Indeed, the mere fact that two references can be combined is not a substitute for the required showing of a motivation to combine. *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); *In re Fitch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). This ideal is essential to reject claims as being an obvious combination of two prior art references, and simple assertions that there is a motivation to combine references without providing the

motivation amounts to nothing more than speculation or hindsight reconstruction, both of which are insufficient to support an obviousness rejection. *In re Fitch*, 972 F.2d at 1266. Therefore, the Examiner has failed to provide a motivation to combine Kovacs with Takada et al, and Claims 8-19 remain in condition for allowance.<sup>1</sup>

**B. A Motivation to Combine does not Exist because the Examiner's Explanation Both Renders the Prior Art Unsatisfactory for Its Intended Purpose and Changes the Principle of Operation of the References**

The Examiner stated on p. 4 that:

Secondly, Takada et al also have the inlet and outlet in the cylinder head and, as seen in figure 1, the valves are also in the cylinder head. While Takada et al have merely been cited for its lubrication system and valve drive (it also being lubricated by splashed oil), one of ordinary skill in the art could easily drive two inlet valves and it would not destroy the Takada et al reference.

The Examiner also stated:

As to how to combine the references, one of ordinary skill in the art would have merely incorporated the lubrication system in the engine of Kovacs. While the examiner had previously allowed the claims, upon further reconsideration the claims are deemed obvious. The claims were never allowed after having made a rejection based on Kovacs and Takada et al.

The Examiner has wrongly characterized the structure taught in Kovacs. As previously explained by the Appellants, Kovacs requires two inlet openings: one in the cylinder head and the other in the cylinder center. The second inlet opening taught in Kovacs is not located in the cylinder head as the Examiner contends. Instead, the second inlet opening taught in Kovacs is located in the

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<sup>1</sup> At p. 5, the Examiner also "contends that motivation exists because all four-stroke engines have lubrication system external to the combustion cylinder and Kovacs merely admits to such a necessity without showing any details of the lubrication system. Hence, Takada et al are cited because details of the lubrication system are set forth." However, once again, the Examiner points to nothing in support of this statement.

center of the cylinder wall. The cylinder head is the area located above the cylinder, and the cylinder wall is located below the cylinder head and provides for the surface adjacent to the path of travel of the piston. (Appeal Brief, Tab B, p. 2). The second inlet located in the center of the cylinder wall is not located in the cylinder head, and the assertion by the Examiner that both inlets taught in Kovacs are located in the cylinder head is wrong. The lubrication system taught by Takada et al is directed to providing lubrication to inlets and outlets located in the cylinder head, and does not provide lubrication to an inlet and outlet located in the center of the cylinder wall. Thus, the assertion that the lubrication system taught in Takada et al would service the inlet and outlet located in the center of the cylinder wall, as taught in Kovacs, is in error. On the contrary, making such a combination would require elimination of the cylinder inlet in Kovacs which is not permitted as it would render the prior art unsatisfactory for its intended purpose and change its principle of operation. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Hence, it would not be obvious to one skilled in the art to combine a lubrication system that would not provide sufficient lubrication to all necessary parts taught in Kovacs.

**C. The Examiner's Statement About the Knowledge of One Skilled in the Art Is Unsupported and Contrary to the Evidence**

The Examiner stated on p. 5 that:

The examiner contends that change of size is a well settled matter of design choice (*In re Rose*, 105 USPQ 237). There is no reason that one of ordinary skill would not expect a merely smaller engine to work. Lastly, the limitations of "hand-held", "portable", and "lightweight" are somewhat subjective such that a very strong man would be able to carry a power tool with an unminiaturized four-stroke engine.

The Examiner's contention is contrary to the evidence of record. In particular, the article entitled *The Little Engine that Could*<sup>2</sup> which has been cited and attached numerous times states the complete opposite (Amendment dated March 28, 2005; Response to Office Action dated June 13, 2005; and Appeal

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<sup>2</sup> Judith Anne Gunther, *The Little Engine that Could*, Popular Science, March 1993, at 90, 92.

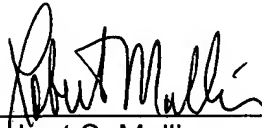
Brief dated September 12, 2005). The article indicates that the scientific community recognized that miniaturization alone would not accomplish what Appellants have invented. (Appeal Brief, Tab H). The article details why one skilled in the art would not expect mere miniaturization of a four-cycle engine to work. Hence, the Examiner's contention that mere miniaturization of a four-cycle engine is unsupported and contrary to findings provided in the article.

The Examiner's newly raised statements that the terms "hand-held," "portable," and "lightweight" are "somewhat subjective" because a "very strong man would be able to carry a power tool with an unminiaturized four-stroke engine" is also unsupported. The specification makes clear that "the four-cycle engine is mounted to a frame to be carried by an operator during normal use" (Spec., p. 3), and prior art four-cycle engines weighed approximately forty pounds (see *The Little Engine that Could*, p. 92). One of ordinary skill in the art would never interpret these terms to mean that only a "very strong man" could carry the device. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 75 USPQ2d 1321 (Fed. Cir. 2005) (stating "the ordinary and customary meaning of a claim term is the meaning the term would have to a person of ordinary skill in the art in question at the time of the invention").

## **II. CONCLUSION**

The arguments put forth in the Examiner's Answer are insufficient to support a rejection of Claims 8-19 under 35 U.S.C. § 103(a). Accordingly, Appellants submit that the present invention is fully patentable over Kovacs and Takada et al. and the Examiner's rejection should be REVERSED.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert S. Mallin", is written over a horizontal line.

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